

IV. REMARKS:

A. Drawing Concerns:

Examiner's Drawing Concerns: The Examiner expressed concern regarding the use of photographs, stating that “All of the photos should be replaced with drawings.” See office action of Feb. 9, 2005, page 2, par. #4. The examiner also expressed concern that “Figs. 11-12 should be designated by a legend such as – Prior Art – because only that which is old is illustrated.” See office action of Feb. 9, 2005, page 3, par. #5.

Response to Examiner's Drawing Concerns: In response to the Examiner's drawings concerns, the Assignee has replaced all of the photographs – Figs. 4 - 13 – with drawings. It is believed that no new matter is added by these drawing changes. The Assignee has also added the legend “Prior Art” to Figs. 10 and 12. A set of replacement drawings (with Figs. 4-13 replacing the originally filed Figs. 4-13) is attached herewith and forms part of this reply. Assignee indicates that a “Prior Art” legend has not been added to Fig. 11 because the only part of that drawing that is prior art is the decoy; the part to which its feet are attached is an embodiment of the inventive technology. To clarify this, and to correct an error of omission (the originally filed description of Fig. 11 was incomplete), the Assignee has amended the specification's Fig. 11 description as indicated above in the Amendments to the Specification section.

B. 35 USC §112 Concerns:

Examiner's Concerns: The Examiner expressed concerns under 35 USC §112 as to claims 2, 4, 39, 50, 102, 118, 122 and 143 for various reasons.

Assignee' Response: In response, the Assignee has canceled claims 2, 39, 102, 122, and 143 (in addition to canceling claim 62). In response to the concern regarding claims 4 and 118, the Assignee has added a period after each of these claims. In response to the examiner's antecedent basis concern regarding claim 50, the Assignee indicates that although this claim has been canceled, its limit (or at least a portion thereof) has been incorporated into claim 1. The text

relating to the limit of claim 50 that now appears in claim 1 has been changed relative to how it appeared in claim 50 as originally filed, in response to the Examiner's concerns. Thus, it is believed that the examiner's antecedent basis concerns as to the use "market condition" of claim 50 as originally filed have been resolved and should not apply to claim 1 as amended.

C. 35 USC §103 Concerns:

Examiner's Concerns: The Examiner expressed concerns under 35 USC §112 as to claims 1-5, 31-45, 50-51, 52-63, 89-108, 113, 116, 119-123, 127-128, 129-137, 140-145, 146-147, and 148-149 as being unpatentable over Babbitt *et al.* US Pat. No. 6,212,816 (referred to hereinafter as Babbitt '816). Without making any admission as to the patentability of the claims as originally filed, and merely to expedite prosecution of the application, the Assignee has amended each of the independent claims remaining in the application at this time (claims 1, 52, 116, 129, 146 and 148). The Assignee explains as follows why the claims as amended are not obvious.

1. The Pending Claims as Amended are Not Prima Facie Obvious: Assignee first submits that the claims remaining in the application after entry of the amendments made herein – claims 1, 3-5, 31-38, 40-45, 51-61, 63, 89-94, 96-101, 103-108, 114-116, 118-121, 123, 127-137, 140-142 and 145-149 – are not *prima facie* obvious, as they must to support a 35 USC §103 rejection. As the Examiner is well aware, "[T]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." MPEP 2142. The MPEP goes on to state that "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP 2143, Basic Requirements of a *Prima Facie* Case of Obviousness. Assignee submits that these three criteria can not be met with respect to the 35 U.S.C §103 and explains its position as follows:

(a) The Prior Art Reference Does Not Teach or Suggest All Claim Limitations of

the Pending Claims:

The reference upon which the examiner relies for this §103 concern – Babbitt ‘816 – simply does not disclose all of the limits of the independent claims, as the Examiner suggests. It therefore does not disclose all of the limits of the claims that depend from these independent claims and, as is well understood, any claims depending from a non-obvious claim are themselves non-obvious.

The following are examples of limits that, either alone or in combination, are not disclosed by Babbitt ‘816:

Independent Claim 1:

wherein said gamebird decoy moving apparatus is usable to move each of at least three different types of said separately commercially available gamebird decoys at different times without requiring substantive modification of any of each of said at least three different types of said separately commercially available gamebird decoys, and

wherein said separately commercially available gamebird decoy is sold in a market condition that does not reflect any adaptation that is specifically intended to facilitate use of said separately commercially available gamebird decoy uniquely with said gamebird decoy moving apparatus

Independent Claim 52:

wherein said animal decoy requires no modification in order to be moved by said animal decoy moving apparatus, and

wherein said separately commercially available animal decoy is sold in a market condition that does not reflect any adaptation that is specifically intended to facilitate its use uniquely with said turntable

Independent Claim 116:

wherein said gamebird decoy moving method is usable to move each of at least three different types of said separately commercially available gamebird decoys at different times without requiring substantive modification of any of each of said at least three different types of said separately commercially available gamebird decoys, and

wherein said separately commercially available gamebird decoy is sold in a market

condition that does not reflect any adaptation that is specifically intended to facilitate attachment of said separately commercially available gamebird decoy to said turntable

Independent Claim 129:

wherein said animal decoy moving method is usable to attach and move each of at least three different types of separately commercially available animal decoys at different times without requiring substantive modification of any of each of said at least three different types of separately commercially available animal decoys, and

wherein said separately commercially available animal decoy is sold in a market condition that does not reflect any adaptation that is specifically intended to facilitate attachment of said separately commercially available animal decoy to said turntable

Independent Claim 146:

wherein said animal decoy is sold in a market condition that does not reflect any adaptation that is specifically intended to facilitate attachment of said animal decoy to said turntable, and

wherein said animal decoy moving method is usable to move a shell decoy; a free-standing, full body decoy, and a post supported decoy, at different times, without requiring modification of said conventional, stationary animal decoys

Independent Claim 148:

wherein said animal decoy moving apparatus is usable to move a free-standing, full body decoy having a foot assembly without requiring removal of said foot assembly of said free-standing, full body decoy

More specifically, as to independent claims 1, 52, 116, 129 and 146 as amended (and their dependent claims), there is simply no disclosure in Babbitt '816 of the subject matter of these claims. The technology disclosed in Babbitt '816 requires either: (a) modification of a conventional decoy after purchase in order for that decoy to be moved by the Babbitt '816 apparatus; or (b) special factory adaptation that is specifically intended to facilitate use of the decoy uniquely with the Babbitt '816 apparatus. As but one additional example of disclosure in Babbitt '816 relative to this, reference is made to the last sentence of the Abstract, stating "A full body, shell or silhouette bird decoys of prior art can be adapted or modified to include the oscillating mechanism and turn or

oscillate like a live bird” (Abstract of US Pat. No. 6,212,816). Reference is also made to column 2, lines 13-33 of Babbitt ‘816. See also, column 5, lines 60-65, and column 6, lines 30-50 of Babbitt ‘816, all including discussion of adaptations that must be made to as-purchased decoys in order that they can be used by the Babbitt ‘816 apparatus. Again, the claims are limited to exclude such modifications, resulting in a simpler, more versatile apparatus that is more quickly and more easily set-up and used than the apparatus disclosed in Babbitt ‘816.

Additionally, as to independent claim 148 as amended (and its dependent claims), there is simply no disclosure in Babbitt ‘816 of an apparatus or method having the above-cited limitation.

The Examiner merely states that, relative to claims 1, 52, 116, 129, 146 and 148, “it would have been obvious to employ at least three different commercial decoys to suit different hunting conditions such as for different game birds and different poses of these birds such as feeding, resting or sentry.” This argument simply does not fulfill any of the *prima facie* requirements of obviousness that the Office must meet in order to support a §103 rejection.

(c) There is No Motivation or Suggestion To Modify the Reference: The Examiner has provided no indication as to motivation or suggestion “either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” MPEP 2143. This is an alternate reason why a *prima facie* obviousness case has not been established.

(c) There is no Reasonable Expectation of Success of the Inventive Subject Matter As Described in the Pending Claims: Simply, the Assignee submits that there is not any evidence suggesting a modification or combination to generate the subject matter of any of the claims would be successful.

2. Reply to the Examiner’s “Obvious to Employ” Argument:

As explained above, the Examiner must meet the requirements of *prima facie* obviousness as presented in MPEP 2143; respectfully, the Assignee explains that an examiner’s

opinion that the claimed subject matter appears obvious, and his statement as such, is an insufficient basis for a valid §103 rejection.

V. CONCLUSION:

The Assignee has amended certain claims, including canceling claims 39, 50, 62, 95, 102, 122, 143, 144, in response to the office action of February 9, 2005, leaving claims 1, 3-5, 31-38, 40-45, 51-61, 63, 89-94, 96-101, 103-108, 114-116, 118-121, 123, 127-137, 140-142 and 145-149 remaining in the application at this time. Further, the Assignee has amended certain drawings and a drawing description of the specification. An allowance of all remaining claims is requested at the Examiner's earliest convenience.

Dated this 9th day of August, 2005.

Respectfully Submitted,
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By: _____

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Express Mail No.: EV 603557616 US

IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE

Applicants: Stephen N. Donnigan, Jeffrey S. Lewis, and Lance E. Smith
Application Number: 10/621,241
Filed: July 15, 2003
Title: Decoy Moving Apparatus and Methods
TC/A.U: 3643
Examiner: Kurt C. Rowan

Assignee: Dynamic Decoy Technologies, LLC
Attorney Docket: DynDecoy-US Nonprov
Customer No. 33549

Exhibit A

10 sheets of Replacement Formal Drawings